

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

In the specification, paragraphs have been amended on pages 1, 2, 4, and 7.

New claims 14-16 have been added.

Applicant respectfully submits that the disclosure of Applicant's application provides support for the amendments to claim 1. For example, at least page 6, lines 8-21, of Applicant's specification provides support for the amendments to claim 1.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1-16 are now pending in this application.

Objection to the Drawings

The drawings are objected to for allegedly not showing every feature specified in the claims. In particular, the drawings are objected to for not showing a throttle member comprising an expansion member, as recited in claim 9. Applicant respectfully traverses this objection.

Applicant submits that the drawings depict a throttle valve DV that may comprise an expansion element, as recited in claim 9. As discussed in Applicant's application at page 6, lines 8-21, the throttle valve DV may comprise an expansion element, as recited in claim 9. If the Examiner does not believe that the drawings of Applicant's application do not satisfactorily depict a throttle valve comprising an expansion element, as recited in claim 9, Applicant respectfully requests the Examiner to provide a suggestion as to how a throttle valve comprising an expansion element, as recited in claim 9, should be depicted.

Reconsideration and withdrawal of this objection is respectfully requested.

Objections to the Specification

The specification is objected to for containing informalities. Applicant respectfully submits that the amendments to the specification render these objections moot. Reconsideration and withdrawal of these objections is respectfully requested.

Rejection under 35 U.S.C. § 112

Claim 9 is rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. This rejection is respectfully traversed. In particular, the Office argues on page 4 of the Office Action that it is not clear “which part/portion/component is to be considered as an expansion element of the throttle member.”

Applicant notes that the breadth of a claim is not to be equated with indefiniteness. See MPEP § 2173.04, citing *In re Miller*, 441 F.2d 689 (CCPA 1971). Although claim 9 may recite that the throttle member comprises an expansion element, the breadth of this limitation, without any further recitation as to what part of the throttle member comprises the expansion element, cannot be considered indefinite because it simply recites that the throttle member comprises an expansion element, as recited in claim 9. Applicant respectfully submits that one of ordinary skill in the art would understand the meaning and scope of claim 9 without any recitation as to which part of the throttle member comprises the expansion element, as recited in claim 9.

For at least the reasons discussed above, reconsideration and withdrawal of this rejection is respectfully requested.

Rejections under 35 U.S.C. § 102

WO 2004/044402

Claims 1-8, 10, and 11 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by WO 2004/044402 to Tomaselli *et al.* (hereafter “Tomaselli”). This rejection is respectfully traversed.

Applicant submits that Tomaselli is not prior art under 35 U.S.C. § 102(b), as argued by the Office, because Tomaselli was published on May 27, 2004, which is not more than one year prior to the filing date of Applicant’s international application, which was filed on February 1, 2005. Applicant notes that the present application is a U.S. national stage

application of an international application and that the filing date of the international application is the filing date of the U.S. national stage application. See MPEP § 1893.03(b).

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See generally MPEP § 2131.

Tomaselli discloses a device that includes a first heat exchange means 30A for exchanging heat between a heat transfer liquid and intake air, a second heat exchange means 30B for exchanging heat between a heat transfer liquid and recirculated exhaust gas, and a valve 50 arranged at a junction between the heat transfer liquid lines for the first and second heat exchange means. See abstract and drawings of Tomaselli.

However, Tomaselli does not disclose that the valve 50 is a throttle member configured to distribute the coolant stream between the at least one heat exchanger and the charge air cooler such that the coolant stream mainly flows through the at least one heat exchanger at low to medium engine loads and speeds and mainly flows through the charge air cooler at high engine loads and speeds, as recited in claim 1. Tomaselli is silent in regard to this feature. Claims 2-8, 10, and 11 depend from claim 1.

For at least the reasons discussed above, Tomaselli does not anticipate claims 1-8, 10, and 11 because Tomaselli does not disclose all of the features of claim 1. Reconsideration and withdrawal of this rejection is respectfully requested.

EP 1 059 432 and U.S. 6,321,697

Claims 1, 3, 4, 6, and 11 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by EP 1 059 432 to Matsuda *et al.* or U.S. Patent No. 6,321,697 to Matsuda *et al.* (hereafter “Matsuda”). This rejection is respectfully traversed. Applicant notes that references to Matsuda hereafter will refer to U.S. Patent No. 6,321,697.

Matsuda discloses a cooling apparatus that includes an exhaust gas recirculation unit 50a and intercooler 50 for a turbocharger. However, Matsuda does not disclose a throttle member configured to distribute the coolant stream between the at least one heat exchanger and the charge air cooler such that the coolant stream mainly flows through the at least one heat exchanger at low to medium engine loads and speeds and mainly flows through the

charge air cooler at high engine loads and speeds, as recited in claim 1. Matsuda is silent in regard to this feature. Claims 3, 4, 6, and 11 depend from claim 1.

For at least the reasons discussed above, Matsuda does not anticipate claims 1, 3, 4, 6, and 11 because Matsuda does not disclose all of the features of claim 1. Reconsideration and withdrawal of this rejection is respectfully requested.

WO 03/069149 and U.S. 2005/0034712

Claims 1-8 and 11 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by WO 03/069149 to Guerrero or U.S. Pub. No. 2005/0034712 to Guerrero (hereafter “Guerrero”). This rejection is respectfully traversed. Applicant notes that references to Guerrero hereafter will refer to U.S. Pub. No. 2005/0034712.

Guerrero discloses a liquid/gas heat exchanger 2 that receives high temperature water, low temperature water, or a mixture of these two waters according to a three-way valve 4 to exchange heat with intake air 15 from a compressor 6 in a first heat exchange section 14 and to exchange heat with recirculation gases in a second heat exchange section 16. See Guerrero at paragraphs 0032-0035 and Figure 2.

However, Guerrero does not disclose that the three-way valve 4 is configured to distribute the coolant stream between the at least one heat exchanger and the charge air cooler such that the coolant stream mainly flows through the at least one heat exchanger at low to medium engine loads and speeds and mainly flows through the charge air cooler at high engine loads and speeds, as recited in claim 1. Guerrero is silent in regard to this feature. Claims 2-8 and 11 depend from claim 1.

Guerrero also discloses a device that includes an engine 58, a main coolant loop 52 for the engine, a main radiator 64, a heater 70 and a line 68 to the heater, a three-way valve connecting the line 68 to the heater with the main radiator 64, a low temperature radiator 78, a heat exchanger 2, and a three-way valve 76 connecting an coolant outlet of the engine with the low temperature radiator 78 and the heat exchanger 2.

However, Guerrero does not disclose that either three-way valve 72 or 76 is configured to distribute the coolant stream between the at least one heat exchanger and the charge air cooler such that the coolant stream mainly flows through the at least one heat exchanger at low to medium engine loads and speeds and mainly flows through the charge air

cooler at high engine loads and speeds, as recited in claim 1. Guerrero is silent in regard to this feature. Claims 2-8 and 11 depend from claim 1.

For at least the reasons discussed above, Guerrero does not anticipate claims 1-8 and 11 because Guerrero does not disclose all of the features of claim 1. Reconsideration and withdrawal of this rejection is respectfully requested.

Rejections under 35 U.S.C. § 103

Claim 9 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tomaselli, Matsuda (EP 1 059 432 or U.S. 6,321,697), or Guerrero (WO 03/069149 or U.S. 2005/0034712) in view of either U.S. Patent No. 4,836,163 to Muschalik (hereafter “Muschalik) or U.S. Patent No. 5,595,065 to Boiarski *et al.* (hereafter “Boiarski”). This rejection is respectfully traversed. Muschalik and Boiarski fail to remedy the deficiencies of Tomaselli, Matsuda, and Guerrero discussed above in regard to independent claim 1, from which claim 9 depends. Reconsideration and withdrawal of this rejection is respectfully requested.

Claims 12 and 13 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tomaselli, Matsuda (EP 1 059 432 or U.S. 6,321,697), or Guerrero (WO 03/069149 or U.S. 2005/0034712). This rejection is respectfully traversed. As discussed above, Tomaselli, Matsuda, and Guerrero fail to disclose or suggest all of the features of claim 1, from which claims 12 and 13 depend. Therefore, Tomaselli, Matsuda, and Guerrero fail to render claims 12 and 13 unpatentable.

The Office suggests on page 10 of the Office Action that the lack of unexpected results weighs in favor of obviousness of claims 12 and 13. Applicant notes that the lack of objective evidence of nonobviousness does not weigh in favor of obviousness. See MPEP § 716.01(a), citing *Miles Labs. Inc. v. Shandon, Inc.*, 27 USPQ2d 1123, 1129 (Fed. Cir. 1993), *cert denied*, 127 L. Ed. 232 (1994).

To the extent that the Office is taking Official Notice in regard to the features of claims 12 and 13, Applicant submits that these features are not commonly known or disclosed in the prior art relied upon by the Office. Applicant respectfully requests that the Office provide prior art to show these features or withdraw the rejection. See M.P.E.P. § 2144.03.

For at least the reasons discussed above, reconsideration and withdrawal of this rejection is respectfully requested.

New Claims

New claim 14-16 have been added. Claims 14-16 depend from claim 1 and are allowable over the prior art for at least the reasons discussed above and for its respective additional recitations.

CONCLUSION

Applicant submits that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing or a credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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